

PATENT APPLICATION
Attorney Docket No.: TRV00-0001-R-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PATENT APPLICATION OF)	
)	Examiner: Hu, Kang
Dennis R. Berman)	
)	Group Art Unit: 3714
Application No.: 10/815,330)	
)	Confirmation Number: 7529
Filing Date: March 31, 2004)	
)	
Title: LOCK-IN TRAINING SYSTEM)	

SUBMITTAL OF MATERIALS FROM CO-PENDING APPLICATIONS

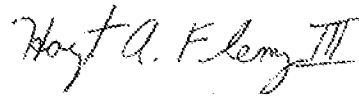
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Recently, the Federal Circuit, in *McKesson Information Solutions, Inc., v. Bridge Medical, Inc.* (2005-1517) affirmed a District Court's determination that a patent was unenforceable due to inequitable conduct. The inequitable conduct was based upon a patent attorney's nondisclosure of office actions from co-pending applications.

In light of *McKesson*, I have attached an office action from a co-pending application of the present application. You may or may not find this office action to be material to the present application.

Respectfully submitted,



Hoyt A. Fleming III
Registration No. 41752

Date: October 18, 2007

Address correspondence to: <input checked="" type="checkbox"/> <i>Customer Number or Bar Code Label</i> 28422	or <input type="checkbox"/> <i>Correspondence Address Below</i> Park, Vaughan & Fleming LLP P.O. Box 140678 Boise, ID 83714	Direct telephone calls to: Hoyt A. Fleming III (208) 336-5237
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/055,306	02/09/2005	Dennis R. Berman	TRV03-0001-3	1500

28422 7590 10/01/2007
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EXAMINER

UTAMA, ROBERT J

ART UNIT	PAPER NUMBER
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3714

MAIL DATE	DELIVERY MODE
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10/01/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 11/055,306	Applicant(s) BERMAN, DENNIS R.	
	Examiner Robert J. Utama	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-44 and 50-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-44 and 50-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7-26-07, 8-21-07, 8-23-07</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. In response to the amendment filed on 08/21/2007, claims 40-44 and 50-59 are still pending. Claims 1-39 and 45-49 have been cancelled.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/21/2007 has been entered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claim 40-42 rejected under 35 U.S.C. 102(b) as being anticipated by Berman US 6,461,166.**

Claim 40: Berman '166 provides a teaching of a computer system to provide training to the users (see Abstract). Berman '166 provides a teaching of a program storage device including a database that stores question and answers to the question (see col. 2:53-63), the answer including at least keyword and at least one non-keyword (see col. 3:20-25 primary keyword and phrases respectively). The database also provides so that at least one keyword of the answer is stored in the database in two locations, the column not storing at least one non-keyword of the answer (see FIG 2A item 30 "Synonym" and col. 3:35-40). The program storage device further includes a computer readable instruction that provide training to at least one user utilizing the

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question, answer to the question and separately stored at least one keyword of the answer (see FIG. 1 and 4:20-60). The system of Berman '166 is capable of providing training that distinguishes at least one non-keyword of the answer from at least one non-keyword of the answer.

Claim 41 and 42: Berman '166 provides a teaching of a program storage device including a database that stores question and answers to the question (see col. 2:53-63), the answer including at least keyword and at least one non-keyword (see col. 3:20-25 primary keyword and phrases respectively). The database also provides so that at least one keyword of the answer is stored in the database in two locations, the column not storing at least one non-keyword of the answer (see FIG 2A item 30 "Synonym" and col. 3:35-40).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claim 43 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Berman US 6,461,166 and in view of Sugimoto US 6,755,661 (hereinafter Sugimoto '661).** Berman '166 fails to explicitly teach of using or storing question number in the database table and of utilizing the question number to provide training. Sugimoto '661 provides a teaching of storing and using question number -along with other attributes related to a particular question- to provide training to at least one user (Sugimoto '661 Col.6:9). Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art to incorporate storing the storing of question number into Berman '166 database, in light of Sugimoto '661

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teaching. One of ordinary skilled in the art would have been motivated to make this combination in order to help the student identify (along certain related attributes) which question have been answered incorrectly.

7. Claim 44 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Berman US 6,461,166 and in view of Bejar US 6,526,258 (hereinafter US '258).

Berman '166 differs from the claimed invention since it does not explicitly teach the storing of question title in a database table. Bejar '258 provides an explicit teaching of a testing machine that store question titles in a system database table (Col 6:37). Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art to incorporate the storing of question title into Berman '166 database, in light of Bejar '258 teaching. One of ordinary skilled in the art would have been motivated to make this combination in order to help the student identify which question topics the student need to focus their attention to.

8. Claim 50 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Berman US 6,461,166 and further in view of Rudmik US 6,551,109 (hereinafter Rudmik '109).

Berman '166 fails to teach the act of storing data of the number of days a user has completed in a multi-day training program. Berman '166 also fails to teach the act of using such data to in order to provide training to the user. Rudmik '109 provides an example of a training system that keep track of the number of days the user have been using the system and using this information to present training bits to the user (Col 3:65-66 and 4:1-17). Rudmik '109 also provides a teaching of how one skilled in the art can use such data to present learning material to the user (Col. 4:15-35). Therefore it would have been obvious to one of ordinary skilled in the art to incorporate Rudmik '109 teaching into the method and system of Berman '166. One

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skilled in the art would have been motivated to make such combination in order to determine the instructional sequence of user in a multi-day training program as taught by Rudmik '109.

9. Claim 51 and 57-59 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Berman US 6,461,166 and further in view of Boon 6,022,221.

Claim 51: Berman '166 fails to provide a teaching a database that stores data and computer readable medium that indicates whether the user is taking Introductory or Retention round of training. However, Boon '221 discloses wherein the database stores data indicating whether a user is taking an Introductory round (i.e., EASY display mode) of training or a Retention round (i.e., reviews) of training, and wherein the program storage device includes computer-readable instructions that when executed by the computer system utilize the data indicating whether a user is taking an Introductory round of training or a Retention round of training (Col.4: 46-48 and Col.5: 18-23). Boon '221 also explains how the data taken during the Introductory (or EASY mode) is used to help train the user (Col.9:26-39). Therefore, it would have been obvious to one of ordinary skilled in the art to include the feature of teaching a database that stores data and computer readable medium that indicates whether the user is taking Introductory or Retention round of training, as taught by Boon '221, because it would enable the system to effectively include the material in a user's short and long time memory (see col. 2:57-65).

Claim 57-59: Berman '166 fails to provide a teaching where the database stores the data and computer readable instruction that indicates the round number where a user successfully answer a question without a hint in the round [**Claim 57**], two times without a hint in the round [**Claim 58**] and X times without a hint in the round where X is an integer greater than 2 [**Claim 59**]. However, Boon '221 et al provides a teaching of a database stores the data and computer readable instruction that indicates the round number where a user successfully answer a question without a hint in the round [**Claim 57**], two times without a hint in the

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round [Claim 58] and X times without a hint in the round where X is an integer greater than 2 [Claim 59] (see Boon '221 col. 7:60-8:10). Therefore, it would have obvious to one of ordinary skilled in to include the feature of database stores the data and computer readable instruction that indicates the round number where a user successfully answer a question without a hint in the round, two times without a hint in the round and X times without a hint in the round where X is an integer greater than 2, as taught by Boon, because it would enable the system to pinpoint mistakes in a user's understanding (see col. 5:50-60).

10. Claim 52-55 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Berman US 6,461,166 and further in view of Cook 5,727,950.

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Claim 52-55: Berman '166 fails to provide a teaching of database that stores data and computer readable instruction that indicates the number of retries by a user in an Introductory round of training (**Claim 52**), the number of retries by a user in an Retention round of training (**Claim 53**), utilizing the number of retries in the Introductory Round to determine the relative difficulty (**Claim 54**) and utilizing the number of retries in the Retention Round to determine the relative difficulty (**Claim 55**). However, Cook 950 provides a teaching a teaching of database that stores data and computer readable instruction that indicates the number of retries by a user in an Introductory round of training, the number of retries by a user in an Retention round of training, and utilizing the number of retries in order to determine the relative difficulty (see Cook '950 col. 49:10-20). Therefore, it would have been obvious to include the feature a database that stores data and computer readable instruction that indicates the number of retries by a user in an Introductory round of training, the number of retries by a user in an Retention round of training, and utilizing the number of retries in order to determine the relative difficulty, as taught by Cook '950, in order to individualized the teaching material to the level of a user's performance (see col. 49:30-42).

Claim 56: Berman '166 fails to provide a teaching of database that stores data and computer readable instruction that indicates the number of times a user utilizes the hint to answer the question. However, Cook 950 provides a teaching a teaching of database that stores data and computer readable instruction that indicates the number of times a user utilizes the hint to answer the question (see Cook '950 col. 49:10-20). Therefore, it would have been obvious to include the feature a database that stores data and computer readable instruction that indicates the number of retries by a user in an Introductory round of training, the number of retries by a user in an Retention round of training, and utilizing the number of retries in order to determine the relative difficulty, as taught by Cook '950, in order to individualized the teaching material to the level of a user's performance (see col. 49:30-42).

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Response to Arguments

11. No arguments were presented along with the amendment submitted on 08/21/2007.

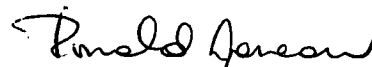
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J. Utama whose telephone number is (571) 272-1676. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezutto can be reached on (571)272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RU



RONALD LANEAU
PRIMARY EXAMINER

9/26/07

Notice of References Cited

Application/Control No.

11/055,306

Applicant(s)/Patent Under
Reexamination
BERMAN, DENNIS R.

Examiner

Robert J. Utama

Art Unit

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Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-6,461,166	10-2002	Berman, Dennis Ray	434/323
*	B	US-5,727,950	03-1998	Cook et al.	434/350
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

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	N					
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	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
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	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
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